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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,439	11/16/2000	Shelton Louie	1205-002/JRD	5706

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT PAPER NUMBER

3627

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,439

Applicant(s)

LOUIE ET AL.

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on 10/4/04, wherein:

claims 1-61 are pending and

claims 1, 24, and 25 have been amended.

It is noted that claims 1, 24, and 25 appear to be amended but the claims are not identified as "currently amended". Clarification is requested.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-7, 9-39, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,464,142 (hereinafter "Denenberg") in view of U.S. Patent No. 6,496,806 (hereinafter "Horwitz").

Denenberg et al disclose a method for taking prescription orders through a retail pharmacy having a plurality of spaced apart locations comprising the steps of receiving the prescription order at a first location upstream of a will call storage area (col. 9, lines 64 through col. 10, line 4); entering data into a computer system at a second location (16); tagging a carrier of the prescription order with a barcode (col. 6, lines 30-38)., manually storing the filled

prescription at one of a plurality of storage locations having a plurality of cubbies (14, 18, 20); detecting the prescription order at one of the plurality of storage locations with a barcode reader (col. 8, lines 46-50); recording the location of the prescription order (col. 6, lines 39-47); and displaying the location on a computer display (col. 13, lines 27-47).

Denenberg et al further disclose the steps of automatically collecting timing information, storing the timing information, and compiling workflow information based on the timing information (col. 16, lines 1-43). A worker can be automatically signaled when the prescription order exceeds a predetermined amount of time (col. 16, lines 30-43). The workflow information may be associated with a particular worker to evaluate worker efficiency (col. 16, lines 2-5).

Denenberg et al do not disclose a tag that is detachably secure to the prescription order or that is rigidly secured to the prescription. However, detachable and rigidly secure tags are both common in the art, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a rigidly secured tag with the invention of Denenberg et al to ensure that the tags aren't mistakenly lost. Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ a detachable tag with the invention of Denenberg et al, so that the tags may be re-used.

Denenberg does not teach the step of detecting the presence of the prescription order at a first station upstream of a storage area. Horwitz et al teach the use of an RFID tag and reader for locating items (see Fig. 4). Horwitz et al teach the step of detecting the presence of an item at a first station (124) and tracking the item upstream of a storage area (108). It would have been obvious to one of ordinary skill in the art at

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the time the invention was made to employ the system of Horwitz with the invention of Denenberg to help individuals locate prescriptions or prescription information anywhere within the pharmacy.

4. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg in view of Horwitz as applied to claim 1 above, and further in view of U.S. Patent No. 4,766,542 (hereinafter "Pilarczyk").

Denenberg and Horwitz teach all of the limitations of the claim except for a teaching of notifying a pharmacy worker if a refill prescription has been prematurely submitted.

Pilarczyk teaches a system for prescription compliance that notifies a worker if a refill has been submitted prematurely (col. 10, lines 5-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Pilarczyk with the combination of Denenberg and Horwitz so that a pharmacist may make note of premature refills.

5. Claims 40 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg in view of Horwitz as applied to claim 31 above, and further in view of U.S. Patent No. 5,926,093 (hereinafter "Bowers").

Denenberg in combination with Horwitz disclose all the claim limitations as set forth above, but fail to explicitly disclose the use of a tag reading employing a switching device.

Bower teaches the use of RFID tag reading employing a switching device (see paragraph bridging columns 10-11):

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Denenberg/Horwitz with the switching device as taught by Bowers, because using a switching device is more efficient (see Abstract).

6. Claims 44-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Denenberg in view of Isaacman.

Denenberg teaches all of the limitations as Claims 44-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over described in paragraph 3 of this Office Action.

Denenberg does not teach a tag reader for each cubby or that items are placed in a cubby without indication from a computer system.

Isaacman teaches a tracking system with an RFID tag and reader (see Fig. 3). Isaacman et al teach that an item can be placed on any shelf or in any drawer without indication from a computer system, and the items will be tracked (see Abstract; Fig. 4, col. 4, lines 45-53; and col. 8, line 61 through col. 9, line 14).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the teachings of Isaacman et al with the invention of Denenberg et al to track items in drawers without indication from a computer system to reduce human error.

Response to Arguments

7. Applicant's arguments filed January 6, 2005⁴ have been fully considered but they are not persuasive.

On pages 14-17, Applicant argues that rejections are not obvious based on empirical evidence. The Examiner fully considered all evidence including Applicant's declaration, Long-Felt need not solved by others, commercial success, and evidence of copying. However, the

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prior references disclose all the limitations as required by the claims and sufficient motivation is provided by the Examiner.

On page 17, paragraph B, Applicant argues that there is not suggestion to combine. The Examiner respectfully disagrees. Sufficient motivation was provided above for each combination.

On page 17, paragraph C, Applicant argues that the prior art fail to disclose a tag reader switching device. The Examiner agrees. Claims 40-41 are rejected in view a new reference (Bowers) which teaches a tag reader switching device.

On page 17, paragraph D (cont. on page 18), Applicant argues that the prior fails to disclose "the computer system comparing the identity of the patient whose filled prescription is being sought by the customer with the patient information associated with the unique tag identifier to verify that the correct prescription order has been removed from the storage area." The Examiner respectfully disagrees. Denenberg discloses comparing the user name (see at least column 10, lines 5-18 and 37-62).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

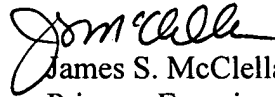
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872-9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
January 6, 2005